

**Notice of Allowability**

Application No.

09/843,126

Applicant(s)

ASTLES ET AL.

Examiner

Art Unit

Celia Chang

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to 09/22/04 amendment and examiner's amendment 11/01/2004.
2. ☐ The allowed claim(s) is/are 1-12, 15-55, 58, 61 and 73-76.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

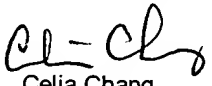
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

  
Celia Chang  
Primary Examiner  
Art Unit 1625

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Art Unit: 1625

### DETAILED ACTION

1. The petition to withdrawn from issued has been granted on Feb. 28, 2005.

This application is a RCE of SN 09/843,126.

Amendment filed dated Sept. 22, 2004 have been entered. Claims 13, 14, 56-57, 59-60, 62-63 have been canceled. Claims 64-72 stayed withdrawn from consideration. Claims 1-12, 15-55, 58, 61, 73-76 are pending.

An IDS has been filed and considered.

2. *Reason for Allowance*

The following is an examiner's statement of reasons for allowance:

Applicants presented that because of the description in US 5,442,064 at col. 1, lines 63-68, the compounds of '064 patent will not support a carbonyl bonding to a heterocyclic ring at a carbon atom. A survey of the structural delineation from cas (see CA structure for US 5442064 attached) evidenced that such interpretation is correct. Therefore, the 103(a) rejection is dropped. Applicants have authorized cancellation of all the non-elected claims. Thus, claims 1-12, 15-55, 58, 61, 73-76 are allowed.

The recited references on the IDS are the patent family of US 6,812,236. the subject matter of the '236 patent differ from the instant claims in that when the R3 substituents on the 1-position of the piperidiny ring is carbonyl containing, i.e. the  $-W-A^1-N(R^{12b})(R^{12c})$  and W is CO, there must be an amino i.e. the  $-N(R^{12b})(R^{12c})$  at its terminal while the instant claims are drawn to compounds wherein the corresponding R3 does not contain such terminal  $N(R^{12b})(R^{12c})$  group. In addition, all the examples and preparation of the '236 patent have a 2,3-dimethyl substituted piperidine which is considered a teaching away from the instant claims wherein only one R4 is allowed on the piperidiny ring. In re Baird 29 USPQ2d 1550.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

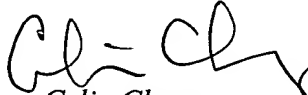
Art Unit: 1625

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
May 27, 2005

  
Celia Chang  
Primary Examiner  
Art Unit 1625